

REMARKS

Applicant respectfully requests reconsideration of this application. Claims 1-25 are pending in the application. No claims have been amended or canceled.

The Examiner rejected claims 1-6, 10-16, and 20-25 under 35 U.S.C. §103(a) as being unpatentable over Magnus et al. (WO 02/082359; hereinafter "Magnus") as modified by Zdybel, Jr. et al. (U.S. Patent No. 5,486,686; hereinafter "Zdybel, Jr.").

Applicant respectfully traverses the rejection.

With respect to claim 1, Applicant respectfully submits that the present invention as taught by claim 1 includes "automatically sending the one or more edits made on the hardcopy representation, via wireless transmission, to a computer system" (claim 1, emphasis added). In contrast, Magnus does not disclose automatically sending edits to a computer system. According to Magnus:

When the desired amount of written information has been stored in the memory, this can be transmitted at an optional time and be sent on wirelessly via a transmitter 7 which in a preferred embodiment is a so-called Bluetooth® transmitter.

(Magnus, p. 7, lines 28-32; emphasis added).

The Examiner quoted the above section from Magnus and requested Applicant to further review Magnus by giving its broadest reasonable interpretation. Applicant respectfully complies and submits that the above passage from Magnus does not disclose, suggest, or imply automatically sending the edits via a wireless transmission. To the contrary, "optional" means *not automatic* according to Webster's II New College Dictionary (published by Houghton Mifflin Company, © 2001). The word "optional" quantifies the word "time," therefore, the time at which the information may be sent is selectable, and thus, not automatic. Therefore, Magnus teaches away from the present invention as claimed.

Furthermore, other embodiments disclosed in Magnus are also consistent with the interpretation of the sentence quoted above from Magnus. For example, Magnus discloses that a user has to actuate a send button, to move the writing and reading unit across a specific place, or to mark a specific send box on the coupon in order to send information from the writing and reading unit (Magnus, p. 3, lines 8-17; p. 8, lines 15-17). Since a user has to affirmatively carry out one or more acts to cause the writing and reading unit in Magnus to send information, the writing and reading unit in Magnus does not automatically send edits via wireless transmission. Therefore, Magnus does not disclose, suggest, or imply automatically sending edits.

Moreover, Zdybel, Jr. does not overcome the deficiency of Magnus. Zdybel, Jr. does not disclose "automatically sending the one or more edits made on the hardcopy representation, via wireless transmission, to a computer system." Since the combination of Magnus and Zdybel, Jr. does not disclose every limitation in claim 1, they do not render claim 1 obvious under §103(a). Applicant respectfully requests the Examiner to withdraw the rejection.

Since Magnus and Zdybel, Jr. do not disclose every limitation in claim 1, it is not necessary to discuss whether one of ordinary skill in the art would be motivated to combine Magnus and Zdybel, Jr., and therefore, this issue is not discussed here. However, Applicant reserves the right to argue this issue in the future.

Claims 2-13 depend, directly or indirectly, from claim 1. For at least the reason discussed above with respect to claim 1, claims 2-13 are patentable over Magnus in view of Zdybel, Jr. Applicant respectfully requests the Examiner to withdraw the rejections.

Applicant respectfully submits that claims 14 and 24 are patentable over Magnus in view of Zdybel, Jr. for at least the reason discussed above with respect to claim 1. The Examiner is respectfully requested to withdraw the rejections.

Claims 15-23, and 25 depend, directly or indirectly, from claims 14 and 24 respectively. Therefore, claims 15-23, and 25 are patentable over Magnus in view of Zdybel, Jr. for at least the reason discussed above with respect to claims 14 and 24.

With respect to claims 7-9, and 17-19, the Examiner rejected them under 35 U.S.C. §103(a) as being unpatentable over Magnus, as modified by Zdybel, Jr. as applied to claim 1, and further in view of Patton et al. (U.S. Patent No. 5,757,468; hereinafter "Patton"). For the reasons discussed above with respect to claim 1, and at least one additional reason, Applicant respectfully traverses the rejection.

Applicant respectfully submits that there is no motivation for one of ordinary skill in the art to combine Patton with Magnus and Zdybel, Jr. to come up with the present invention as claimed in claims 7-9, and 17-19. Patton is directed to associating sound with still images (Patton, column 1, lines 15-20), not updating an electronic application with edits made to hardcopy representations of the electronic application. Applicant respectfully submits that Patton is directed to a distinct and separate problem from the one solved by the present invention as claimed, and therefore, one of ordinary skill in the art would not have been motivated to look to Patton for a solution to the problem identified in the present application. However, the Examiner argued in the Final Office Action that it would have been obvious to combine Patton with Magnus as modified by Zdybel, Jr. "in order to provide a visual acknowledgement of the information (i.e. ID) printed with an icon to the operator to further offer an aesthetic appeal to the hard copy." (Final Office Action, p. 4, third paragraph). Applicant respectfully submits that aesthetic appeal is not an issue in either Magnus or Zdybel, Jr. and neither Magnus nor Zdybel, Jr. expresses any concern on aesthetic appeal of the hard copy. Therefore, one of ordinary skill in the art would not have any motivation to combine Magnus and Zdybel, Jr. with Patton. Applicant respectfully submits that the

present invention as claimed is not obvious in view of Magnus, Zdybel, Jr., and Patton.


Applicant respectfully requests the Examiner to withdraw the rejection under §103(a).

Accordingly, Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been overcome by the remarks and withdrawal of these rejections is respectfully requested. Applicant submits that claims 1-25 are now in condition for allowance and such action is earnestly solicited.

Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,
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Juanita Briscoe July 21, 2003
Date